UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Applicati n N.	Applicant(s)
Office Action Summary	10/003,707	LEONID ET AL.
	Examiner	Art Unit	
	Thu V Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 November 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>07/26/2002</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: IDS filed on 07/26/2002; and application

filed on 11/02/2001, which has the benefit of prior provisional filed on 11/06/2000.

2.   Claims 1-36 are pending in the case. Claims 1 and 36 are independent claims.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

4.   Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

         Regarding independent claim 36, the use of "systems and methods as substantially

disclosed herein" is an omnibus claim. This claim is indefinite in that it fails to point out what is

included or excluded by the claim language. See MPEP § 706.03(d) and MPEP 21 1302.04(b).

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
requirements of this title.

         Claim 36 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable

utility.

Double Patenting

5.   A rejection based on double patenting of the "same invention" type finds its support in
the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new
and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term
"same invention," in this context, means an invention drawn to identical subject matter.
See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114
USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by
canceling or amending the conflicting claims so they are no longer coextensive in scope.
The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based
upon 35 U.S.C. 101.

6.   Claims 10, 11 and 12 are objected to under 37 CFR 1.75 as being a substantial duplicate

of claims 6, 5 and 13 respectively. When two claims in an application are duplicates or else are

so close in content that they both cover the same thing, despite a slight difference in wording, it

is proper after allowing one claim to object to the other as being a substantial duplicate of the

allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
sale in this country, more than one year prior to the date of application for patent in the United States.

8.   **Claims 1-5, 7-9, 11, 15, 16-20, 24-32 are rejected under 35 U.S.C. 103(a) as being**

anticipated by Rivvette et al., US 5,799,325 issued 08/1998, as supplied by the Applicants in

IDS filed 07/26/2001.

Regarding independent claim 1, Rivette teaches the steps of:

- processing the document text into an index that identifies the text locations of

  reference symbols (Rivette, col.10, lines 28-30, 38-50; col.15, line 61 – col.16, line

  27; col.17, lines 11-19; col.27, lines 52-67; col.35, lines 35-67; paginating PTO text

  files and PTP image files that identifies locations of columns, sections, sentences,

  figure numbers);

- processing the document graphics into an index that identifies the graphic locations of

  reference symbols (Rivette, col.10, lines 28-30, 38-50; col.15, line 61 – col.16, line

  27; col.17, lines 11-19; col.19, lines 55-62; col.27, lines 52-67; col.35, lines 35-67;

  paginating PTO text files and PTP image files that identifies locations of columns,

  sections, sentences, figure numbers);

- displaying the text that includes at least one of the text reference symbols or

  displaying at least some of the graphic reference symbols (Rivette, col.34, lines 13-

  29; col.35, lines 48-67); and

- linking the common text and common graphic reference symbols such that user

  selection of particular text reference symbol or graphic reference symbol causes

  display of a respective graphic segment or text segment that includes the selected

  common reference symbol (Rivette, col.3, lines 36-39, col.4, lines 10-49; col.15, line

  61 – col.16, line 27; and col.17, lines 11-19; col.27, lines 52-67; col.34, lines 13-29;

  col.35, lines 48-67; user selects figure number in text file causes display the

  corresponding figure in the image file).

Regarding dependent claim 2, which is dependent on claim 1. Rivette teaches wherein each graphic reference symbol includes one or a combination of number (s), letter (s), and word (s) (Rivette, col.18, lines 51-57; col.34, lines 13-29; col.35, lines 48-67; figure number in image file).

Regarding dependent claim 3, which is dependent on claim 1. Rivette teaches wherein each text reference symbol includes one or a combination of number (s), letter (s), and word (s) (Rivette, col.18, lines 51-57; col.34, lines 13-29; col.35, lines 48-67; figure number in text file).

Regarding dependent claim 4, which is dependent on claim 1. Rivette teaches wherein each graphic reference symbol includes one or a combination of number (s), letter (s), and word (s) and each text reference symbol includes one or a combination of number (s), letter (s), and word (s) and wherein each common text and graphic reference symbol includes the same one or a combination of number (s), letter (s), and word (s) respectively (Rivette, col.18, lines 51-57; col.34, lines 13-29; col.35, lines 48-67).

Regarding dependent claims 5 and 11, which are dependent on claim 1. Rivette teaches highlighting displayed text reference symbols which are linked to graphic reference symbols (Rivette, col.4, 40-49; col.35, lines 48-47; col.36, lines 19-41; highlighting all corresponding element numbers in the text file in response to user selection of an element number in the image file).

Regarding dependent claim 7, which is dependent on claim 5. Rivette teaches

displaying all corresponding graphic segments in response to user selection of a particular

displayed text reference symbol and wherein each corresponding graphic segment includes the

reference symbol common to said selected text reference symbol (Rivette, col.34, lines 13-29;

col.35, lines 48-67; corresponding figure numbers in the image file are displayed in response to

user selection of figure number in the text file).

Regarding dependent claim 8, which is dependent on claim 5. Rivette teaches the

limitations of claim 5 as explained above, Rivette teaches displaying the locations or sheet

numbers of corresponding graphic segments in response to user selection of particular

displayed text reference symbol and wherein each corresponding graphic segment includes the

reference symbol common to said selected text reference symbol (Rivette, col.34, lines 14-29;

col.35, lines 48-47).

Regarding dependent claim 9, which is dependent on claim 8. Rivette teaches

displaying the corresponding graphic segments in response to user selection of particular

displayed reference symbol location or sheet number (Rivette, col.34, lines 13-29; col.35, lines

48-47).

Regarding dependent claim 15, which is dependent on claim 1. Rivette teaches

displaying a list that includes the text identities of components and the reference symbol

associated with each text component (Rivette, col.27, lines 36-65, displaying a list of text

identities of sections and reference symbol (letters) associated with each text section in the text

file when the user selects one of various text identities of section).

Regarding dependent claim 16, which is dependent on claim 15. Rivette teaches

wherein the list is arranged in alphabetical order of component text identities or in order of the

reference symbol associated with each text component (Rivette, fig.32; the list 170 is arranged

in order of the reference symbol displayed in the text file).

Regarding dependent claim 17, which is dependent on claim 15. Rivette teaches

wherein each component text identity comprises a noun group (Rivette, col.27, lines 36-65, and

fig.14 item 170).

Regarding dependent claim 18, which is dependent on claim 15. Rivette teaches

wherein user selection of a component text identity in the displayed list causes display of a text

segment that includes the selected component text identity (Rivette, col.27, lines 36-65).

Regarding dependent claim 19, which is dependent on claim 18. Rivette teaches

wherein the full document text displayed is forward/backward scrollable by user command

(Rivette, fig.14, the window text document 160 comprise scroll bar for the user navigate the

document).

Regarding dependent claim 20, which is dependent on claim 18. Rivette teaches

wherein the list, graphic, and text are displayed in separate windows the area of which

windows are variable by user command (Rivette, col.27, lines 36-65 and fig.14).

Regarding dependent claim 24, which is dependent on claim 1. Rivette teaches

wherein displayed text segment is displayed as part of the document text and displayed

document text is scrollable, fore and aft, in response to user command (Rivette, col.27, lines

36-65 and fig.14; the window text document 160 comprise scroll bar for the user navigate the

document).

Regarding dependent claim 25, which is dependent on claim 24. Rivette teaches

wherein the user display includes at least two windows, a text window and a graphic window,

and the selected and displayed text segment is initially displayed in the vertical mid-region of

the text window (Rivette, col.17, lines 11-19; col.27, lines 36-65; col.34, lines 14-29; fig.33).

Regarding dependent claim 26, which is dependent on claim 1. Rivette teaches

wherein the displayed graphic segment is displayed as part of the document graphic and the

displayed document graphic is zoom-able, inward and outward, in response to user command

(Rivette, col.34, line 14 - col.35, line 2).

Regarding dependent claim 27, which is dependent on claim 24. Rivette teaches

wherein user display includes at least two windows, the text window and a graphic window,

and the selected and displayed graphic segment is initially displayed in the vertical mid-region

of the graphic window (Rivette, col.17, lines 11-19; col.27, lines 36-65; col.34, lines 14-29;

fig.33).

Regarding dependent claim 28, which is dependent on claim 8. Rivette explicitly

teaches wherein said locations or sheet numbers are displayed in a sub-window (Rivette, fig.

31, wherein "column: 3" is displayed in a separate window 160 on left side).

Regarding dependent claim 29, which is dependent on claim 13. Rivette teaches

wherein said corresponding text segments are displayed in a sub-window (Rivette, col.4, lines

41-48 and fig.36).

Regarding dependent claim 30, which is dependent on claim 1. Rivette teaches

displaying simultaneously the text segment and the graphic segment that include the selected

common reference symbol (Rivette, col.4, lines 41-48; col.17, lines 11-19; col.34, lines 14-29;

col.35, lines 48-67).

Regarding dependent claim 31, which is dependent on claim 30. Rivette teaches

printing or storing in a separate file, the simultaneously representations of displayed text

segment and graphic segment (Rivette, col.39, lines 37-50; printing image and text files).

Regarding dependent claim 32, which is dependent on claim 1. Rivette teaches storing

the text locations of all sentences and word in the document (Rivett, col.24, lines 25-54; col.30,

line 36 – col.31, line 13; col.32, lines 30-59; locations of sentences or word in the document

must be stored in order to provide the search results/terms to the user).

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

> (b) This application currently names joint inventors. In considering patentability of the claims under 35
> U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the
> time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the
> obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly
> owned at the time a later invention was made in order for the examiner to consider the applicability of 35
> U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10.   Claims 6, 10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Rivvette et al., US 5,799,325 issued 08/1998, as supplied by the Applicants in IDS filed

07/26/2001.

Regarding dependent claims 6 and 10, which is dependent on claim 1. Rivette does not

explicitly disclose highlighting displayed graphic reference symbols which are linked to text

reference symbols. However, Rivette teaches highlighting displayed text reference symbols

(Rivette, col.4, lines 32-48) which are linked to graphic reference symbols (Rivette, col.4, lines

13-20 and col.17, lines 11-19).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have modified Rivette to includes highlighting displayed graphic

reference symbols which are linked to text reference symbols, since the modification would

have helped to further illustrate the linked reference symbols between text and image files.

Regarding dependent claims 12 and 13, which is dependent on claim 10. Rivette

teaches displaying all corresponding text segments in response to user selection of a particular

displayed graphic reference symbol and wherein each corresponding text segment includes the

reference symbol common to said selected graphic reference symbol (Rivette, col.4, lines 41-

48).

Regarding dependent claims 14, which is dependent on claim 13. Rivette teaches

displaying the corresponding text segment and preceding and following text thereof in

response to user selection of a particular display text segment (Rivette, col.4, lines 41-48).

11.   **Claims 21-22, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Rivvette et al., US 5,799,325 issued 08/1998 and in view of Tel, US 5,943,648 issued 08/1999.**

Regarding dependent claims 21-22, and 33. Rivette does not explicitly teaches

synthesizing a user selected text segment or the sentence in which a user selected text segment

appears, and converting the synthesized text segment or sentence into an audible segment or

sentence audible to the user, and wherein the graphic is displayed during the time the audible

segment or sentence is audible to user.

Tel teaches converting text segment or sentence into an audible segment or sentence

audible to the user (Tel, col.1, lines 5-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Tel's teaching into Rivette to convert text segment into audible segment, since the combination would have provided the user's many working environment and user interface for examination of text and image files.

12.   **Claims 23, 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivvette et al., US 5,799,325 issued 08/1998 and in view of Richards, US 6,038,534 issued 03/2000.**

Regarding dependent claims 23, and 34-35. Rivette does not explicitly teach wherein · user selection includes user speaking an audible command and using voice recognition methods to convert the audible command into a digital computer instruction; user speaking a predetermined command and said predetermined work and, using voice recognition methods, converting the spoken predetermined command and said predetermined word into a digital computer instruction.

Richards teaches using voice command and voice recognition method to convert the audible command to generating keyboard commands (Richards, summary).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Richard's teaching into Rivette to convert audible command into digital computer instruction, since the combination would have provided the user's many working environment and user interface for examination of text and image files.

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Khoyi et al., US 5,303,379, filed 1992, teaches linking data between objects and performing operations on the linked data in an object based system.

Borgendale et al., US 5,276,793, filed 1990, teaches method for editing a structured document to preserve the intended appearance of document elements.
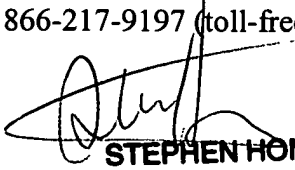
Jones et al., US 2001/0047373 A1, filed 1998, teaches publication file conversion and display.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 273-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S Hong can be reached on (571) 273-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

TVH
December 22, 2004